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REMARKS

Claims 1-28, and 30 are all the claims presently pending in the application. Claims 1-3, 6-10, 13-14, 16, 24, and 30 are amended to more clearly define the invention and claim 29 is canceled. Claims 1, 6, 9-10, 13, and 24 are independent.

Applicant thanks Examiner Gauthier for the courtesies extended to the Applicant's representative during a personal interview on November 3, 2004. During the personal interview, Examiner Gauthier agreed that "the reference does not disclose the invention." (see Enclosed Examiner's Interview Summary Record). Therefore, Applicant respectfully requests withdrawal of the rejection and allowance of the present application.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicant also notes that, notwithstanding any claim amendments herein or later during prosecution, Applicant's intent is to encompass equivalents of all claim elements.

Entry of this §1.116 Amendment is proper. Since the Amendments above narrow the issues for appeal and since such features and their distinctions over the prior art of record were discussed earlier, such amendments do not raise a new issue requiring a further search and/or consideration by the Examiner. As such, entry of this Amendment is believed proper and Applicant earnestly solicits entry. No new matter has been added.

Claims 13-18, 21-26, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Brennan reference. Claims 1-12, 19-20, 27-28, and 30 stand rejected under 35 U.S.C. §

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103(a) as being unpatentable over the Brennan reference in view of the Muramatsu reference.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

A first exemplary embodiment of the claimed invention, as defined, for example, by independent claim 13, is directed to a mobile communications terminal that includes a memory storing a character string for a calling party, the character string to be retrieved from the memory upon a receipt of a call from the calling party for outputting voice information and upon receipt of an instruction from a user during an incoming call.

A second exemplary embodiment of the claimed invention, as defined, for example, by independent claim 1, is directed to a mobile communications terminal device that includes storage means for registering beforehand a name of an originator, one of a telephone number and a mail address of the originator, a kind of an incoming identification tone at a time of a call incoming from the originator, and a character string corresponding to a voice information designating the originator, voice output means for ringing with the kind of the incoming identification tone corresponding to the originator at the time of the call incoming, and control means for controlling the voice output means to output the voice information corresponding to the character string registered beforehand in the storage means in response to an instruction received from a user while the voice output means is ringing.

Conventional mobile terminals have displayed a caller's data from a telephone directory when a call is received from that caller. However, a user of the mobile terminal cannot easily

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identify the caller if the display is not visible.

Other conventional mobile terminals output a tone that identifies a caller when a call is received from that caller. However, it is difficult for a user to accurately and easily identify a caller if a large number of caller's and identifying tones are stored.

In stark contrast, the mobile terminal in accordance with an exemplary embodiment of the present invention outputs voice information based upon a character string that was stored before the call from the party and upon receipt of an instruction from a user during an incoming call. In this manner, when an originator's information cannot be easily identified based upon the display the user can obtain the voice information by providing the instruction to the phone. (Page 11, lines 4-20).

Additionally, since it is not necessarily beneficial to the user for the mobile terminal to be automatically output since the originator's information may be undesireably heard in the surroundings, the present invention outputs the voice information in response to receipt of an instruction from a user during an incoming call. (Page 9, lines 1-17).

II. THE PRIOR ART REJECTIONS

A. The Brennan reference

Regarding the rejection of claims 13-18, 21-26, and 29, the Examiner alleges that the Brennan reference teaches the claimed invention. Applicant submits, however, that there are elements of the claimed invention which are neither taught nor suggested by the Brennan reference.

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As agreed by Examiner Gauthier during the personal interview, the Brennan reference does not teach or suggest the features of the present invention including: 1) a memory storing a character string for a calling party that is to be retrieved from the memory upon a receipt of a call from the calling party for outputting voice information and upon receipt of an instruction from a user during an incoming call (claim 13); and 2) outputting a voice signal that corresponds to the character string if the character string corresponds to the caller and in response to an instruction from a user during an incoming call from the caller (claim 24). As explained above, these features are important for ensuring that the voice information is not inadvertently output such that the originator's information is heard in the surroundings. Rather, the present invention outputs the voice information in response to an instruction from a user during an incoming call.

In stark contrast, the Brennan reference discloses an automatic answer feature for a telephone that automatically outputs a name from a speech synthesizer without requiring any instruction at all from a user during the incoming call.

In particular, the Brennan reference explains that "Upon completion of a predetermined number of ring cycles (usually only one) . . . the main controller 34 compares the decoded telephone number (or, if no telephone number, the decoded name) to the telephone numbers (or names) previously entered into the telephone directory 48 (step 64). If there is a match . . . the name in the matching record is read from the telephone directory 84 . . . [and] the main controller 34 forwards the read name to the speech synthesizer 80 (step 65) which translates the read name into a voice announcement signal which is output to the handsfree speaker." (Col. 3, lines 3 - 31).

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Thus, the automatic telephone answering system that is disclosed by the Brennan reference suffers from the same problem that is solved by the present invention.

In other words, the automatic telephone answering system that is disclosed by the Brennan reference automatically outputs the name as a voice announcement to the handsfree speaker. Therefore, the voice announcement is heard in the surroundings of the phone without the user of the telephone doing anything.

In stark contrast, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

Moreover, the Brennan reference actively teaches away from the present invention.

As explained above, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

In stark contrast, the Brennan reference teaches away from outputting voice information in response to an instruction from the user during the incoming call by providing an automatic telephone answering system which automatically outputs the voice information to the surroundings because the "operation is useful where the user is handicapped, infirm, or working in a hands-busy situation." (Col. 3, lines 48-57).

In other words, the Brennan reference teaches that the user may be "handicapped, infirm, or working in a hands-busy situation" and, therefore, may be unable to provide an instruction when receiving the incoming call in order to output the voice information into the surroundings.

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Therefore, the Brennan reference teaches that it is not desirable to require any instruction at all from a user before outputting the voice information into the surroundings.

Therefore, the Brennan reference does not teach or suggest each and every element of the claimed invention and the Examiner is respectfully requested to withdraw this rejection of claims 13-18, 21-26, and 29.

B. The Brennan reference in view of the Muramatsu reference

The Examiner alleges that the Muramatsu reference would have been combined with the Brennan reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, the Brennan reference is directed to providing a telephone system that automatically answers a telephone so that "someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected." (Abstract).

In stark contrast, the Muramatsu reference is specifically directed to identifying a caller using sound alone without reducing the number of available communication lines ([0011] - [0013]).

One of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped

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individual may have calls from pre-selected callers automatically connected as the Brennan reference is concerned with providing would not have referred to the Muramatsu reference because the Muramatsu reference is concerned with the completely different and unrelated problem of identifying a caller using sound alone without reducing the number of available communication lines. Thus, the references would not have been combined.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

The Examiner alleges that it would have been obvious to modify the automatic answering system that is disclosed by the Brennan reference to "allow the user to recognize whom is calling before the phone goes off-hook."

However, contrary to the Examiner's allegation, one of ordinary skill in the art would not have been motivated to modify the Brennan reference to "allow the user to recognize whom is calling before the phone goes off-hook" because the answering system that is disclosed by the Brennan reference already allows "the user to recognize whom is calling before the phone goes off-hook."

As is clearly illustrated by the flowchart of Figure 2 of the Brennan reference, the announcement which allows "the user to recognize whom is calling" is performed in step 67, where the handsfree speaker announces the name, then in step 69 the answering system determines if the announcement is complete and, only when the announcement is complete, "the phone goes off-hook." (Col. 3, lines 27-47).

Indeed, the Brennan reference specifically states that "a user will first hear the name of a

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caller announced and the call will then be connected.” (Col. 3, lines 47-50).

Therefore, since the Brennan reference allows “the user to recognize whom is calling before the phone goes off-hook,” clearly, there is no motivation to modify the Brennan reference to “allow the user to recognize whom is calling before the phone goes off-hook” as alleged by the Examiner.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, and as agreed by Examiner Gauthier during the personal interview, the Brennan reference does not teach or suggest: 1) control means for controlling voice output means to output voice information in response to an instruction received from a user while the voice output means is ringing (claim 1); 2) outputting a voice information in response to an instruction received from a user during ringing of an incoming identification tone (claim 6); 3) outputting a voice information at the time of a call incoming in response to receiving an instruction from a user while receiving the incoming call (claim 9); and 4) outputting a voice information corresponding to one of a telephone number and a mail address of an originator in response to receiving an instruction from a user while receiving the incoming call.

The Muramatsu reference does not remedy the deficiencies of the Brennan reference.

The Muramatsu reference discloses storing a sound pattern in a phone directory and then outputting that sound pattern when a calling party corresponds to the sound pattern ([0036]). The sound pattern that is disclosed by the Muramatsu reference is the same as the identification tone

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that is discussed, for example, at page 2, lines 5-10 of the present specification.

In other words, the Muramatsu reference does not teach or suggest anything at all that is related to outputting a voice signal, let alone outputting voice information in response to receiving an instruction from a user while receiving the incoming call.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-12, 19-20, 27-28, and 30.

III. FORMAL MATTERS AND CONCLUSION

The Office Action objects to claims 2-3. This Amendment amends claims 2-3 in accordance with Examiner Gauthier's very helpful suggestion. Applicant respectfully requests withdrawal of this objection.

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1-28, and 30, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

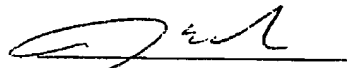
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

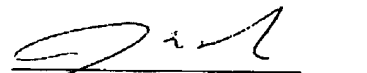
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Amendment by facsimile with the United States Patent and Trademark Office to Examiner Gerald Gauthier, Group Art Unit 2645 at fax number (703) 872-9306 this 12th day of November, 2004.


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